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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

in re application of

William Y. Conwell

Application No.: **09/578,551**

Filed: May 25, 2000

For: CONSUMER DRIVEN METHODS
FOR ASSOCIATING CONTENT
IDENTIFIERS WITH RELATED
WEB ADDRESSES

Examiner: A. Mohammad

Date: December 2, 2003

**Response Under 37 CFR § 1.116
Expedited Procedure**

Art Unit: 2177

Confirmation No.: 5990

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on December 2, 2003, as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, COMMISSIONER FOR PATENTS P.O. Box 1450, Alexandria, VA 22313-1450

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Enclosed for filing in the above-captioned matter are the following:

- Appeal Brief in Triplicate. (No fee is believed due since this reply is in furtherance to a Notification of Non-Compliance. Nevertheless, the Commissioner is authorized, below, to charge our deposit account for any fee needed.)
- Please charge any fees which may be required in connection with filing this Appeal Brief and any extension of time fee, or credit any overpayment, to Deposit Account No. 50-1071.

Date: December 2, 2003

CUSTOMER NUMBER 23735

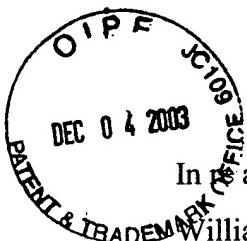
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Respectfully submitted,

DIGIMARC CORPORATION

By _____

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Steven W. Stewart
Attorney for Applicants

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request the Board of Patent Appeals and Interferences (hereafter “Board”) to reverse the outstanding final rejection of the pending claims.

This brief is in furtherance to a Notification of Non-Compliance with 37 CFR 1.192(c) mailed November 28, 2003. A Notice of Appeal was filed May 12, 2003.

Please charge the fee required under 37 CFR 1.17(f) or any deficiency to deposit account 50-1071 (please see the accompanying transmittal letter).

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REAL PARTY IN INTEREST

The real party in interest is Digimarc Corporation, by an assignment from the inventors recorded at Reel 011307, Frames 0595-0596, on November 6, 2000.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1-27 remain pending in the present application. Each of these claims stand finally rejected.

STATUS OF AMENDMENTS

All earlier-filed amendments have been entered.

SUMMARY OF THE INVENTION

The present invention relates generally to associating content and content identifiers with related resources like web addresses. (See, for example, page 1, lines 11-12 and page 4, lines 4-9).

Media content (e.g., audio, video, images) can be associated with corresponding internet resources. In some such approaches, the media content is steganographically encoded (e.g., by digital watermarking) to convey an identifier. When a computer encounters such an encoded audio object, it discerns the encoded identifier, forwards the identifier to a remote database (a "Registry database"), and receives in response - from a database record indexed by the identifier - the address of one or more internet resources related to that audio (e.g., fan sites, concert schedules, e-commerce opportunities, etc.) The computer can then link to such a resource and present same to a user, e.g., using an internet browser program. (See, for example, page 1, lines 19-27 and FIG. 1).

Instead of using steganography to convey an identifier, the identifier can be derived from content itself. (See, e.g., page 2, lines 4-5 and lines 11-26).

Regardless of how content is identified, an issue arises: who manages Registry database addresses represented by corresponding identifiers? (See, e.g., page 3, lines 27-28.).

Some identifiers may not be associated with URLs in a Registry database. A user who queries the database with such an identifier (e.g., which may be derived from an independently produced MP3) finds that there is not yet an associated URL. In this case, the user may be given the opportunity to lease this virtual address for a predetermined period, with the privilege of specifying a URL for that identifier. Subsequent users who link from this particular MP3 file thereafter are directed to the URL specified by the first user. In some arrangements, the leasing privilege is awarded through a brief auction, triggered by the first user's discovery that the address is not used. Other users who query the database with that identifier during the period of the auction are permitted to bid. When the first lease period expires, the privilege can be re-auctioned. Proceeds from such auctions can be shared, e.g., with the user who triggered the first action, or with the high bidder of a previous auction. (See, e.g., page 7, line 18 – page 9, line 13 and Abstract).

Claim 1 recites a method of operating a database that has plural records. The method includes receiving queries, each including an identifier, and replying to the queries by reference to information from database records associated with the identifiers. The identifiers are drawn from a universe of possible identifiers, a majority of which do not have active database records associated therewith. The method includes receiving a query from a user including an identifier that has no active database record associated therewith, the identifier being derived from an existing media content object; and permitting the user to create an active database record corresponding to the identifier. (See, e.g., original claim 1; see also, e.g., page 5, line 27 – page 6, line 18).

Another aspect of the invention as set forth in claim 4 is a method including: i) deriving an identifier corresponding to an existing media content object; ii) querying a database with the derived identifier; and iii) if the database has no active record corresponding to the derived

identifier, permitting a party who first queried the database with said identifier to define such a record. (See, e.g., original claim 4; see also, e.g., page 5, line 27 – page 6, line 18 and page 6, lines 25-27).

Yet another aspect of the invention as set forth in claim 14 is a method of managing a universe of identifiers. Some of the identifiers are active and have internet resources associated therewith, and others of the identifiers are inactive. The method includes receiving a query corresponding to an inactive identifier and, in response, initiating a time-limited auction. A winner of the auction is granted a privilege of associating an internet resource with the identifier for at least a predetermined time period. (See, e.g., page 7, lines 18-25).

Another aspect of the invention, as set forth in claim 16, is a method including auctioning to the highest bidder the privilege of defining a link that is to be associated, for a predetermined time period, with an identifier through a database; and at the expiry of the predetermined time period, re-auctioning the privilege. (See, e.g., page 7, lines 18-25 and page 8, lines 3-13).

ISSUES

- I. Whether claims 14, 16, 17 and 25 are anticipated under 35 U.S.C. 102 by Davis (U.S. Patent No. 6,269,361 B1).
- II. Whether the Office established a *prima facie* case of obviousness under 35 U.S.C. 103 in rejecting claims 1-5, 7-12, 15, 18-24, 26 and 27 as being unpatentable over Davis in view of Eyal (U.S. Patent No. 6,389,467 B1), when (a) the references – collectively – fail to detail all of the elements claimed, and (b) there is no teaching or suggestion in the art that would have led an artisan to modify and combine the references as proposed.
- III. Whether the Office established a *prima facie* case of obviousness under 35 U.S.C. 103 in rejecting claims 6 and 13 as being unpatentable over Davis in view of Eyal and in further view of Thomas (U.S. patent No. 6,401,118 B1), when (a) the

references – collectively – fail to detail all of the elements claimed, and (b) there is no teaching or suggestion in the art that would have led an artisan to modify and combine the references as proposed.

GROUPING OF CLAIMS

Claims 1, 3, 4, 8, 10-17, 19-25 and 27 are each independently patentable.

Claims 1 and 2 are grouped together and stand or fall together.

Claims 4 and 5 are grouped together and stand or fall together.

Claims 4 and 6 are grouped together and stand or fall together.

Claims 4 and 7 are grouped together and stand or fall together.

Claims 8 and 9 are grouped together and stand or fall together.

Claims 8 and 18 are grouped together and stand or fall together.

Claims 16 and 26 are grouped together and stand or fall together.

ARGUMENT

The cited references fail to disclose or teach all of the elements of the pending claims for at least the reasons set forth below. The “Argument” section is divided into three main sections, with each section corresponding to one of the above three Issues.

- I. *Davis (U.S. Patent No. 6,269,361 B1) fails to anticipate claims 14, 16, 17 and 25 since it does not teach or suggest each of the elements recited in these claims.*

Claim 14

Independent claim 14 reads as follows:

14. A method of managing a universe of identifiers, some of said identifiers being active and having internet resources associated therewith, and others of said identifiers being inactive, the method including receiving a query corresponding to an inactive identifier and, in response,

initiating a time-limited auction, a winner of said auction being granted the privilege of associating an internet resource with said identifier for at least a predetermined time period.

Davis discloses an internet search engine where companies can bid for placement of their web sites at the top of a list of search results.

The Davis patent (assigned to GoTo.com, since renamed Overture.com) describes technology employed at yahoo.com, msn.com, and other search engines. A vendor of digital cameras, for example, can bid to pay \$0.63 in order for its link and blurb to appear at the top of search results when a user queries one of these search engines with the search term "digital cameras." Gateway has bid such an amount. Dell has bid \$0.62. The promotional links are displayed in order of the bid amounts. Whenever a user follows one of these promotional links, Gateway or Dell pays the specified amount to Overture (who splits it with Yahoo, MSN, etc.).

Thus, on the Overture.com web page, a search for "digital cameras" is headed by the following:

**Get listed in these results and reach
80% of active Internet users on sites
like Yahoo!, Lycos, AltaVista and MSN.**

1. **Digital Cameras from Gateway®**

With great deals like these, now is the time to update your digital camera. Check out our huge selection of the latest high performance computers and accessories today.
accessories.gateway.com (Advertiser's Max Bid: \$0.63)

2. **Your Online Source for Digital Cameras**

Dell4me has everything you need, from digital cameras to peripherals and more, organized into easy-to-find categories so you can save time and money. We're more than just a computer company.
www.dell4me.com (Advertiser's Max Bid: \$0.62)

3. **Don't Buy It Before You PriceSCAN It!**

PriceSCAN is your unbiased guide to finding low prices on digital cameras.
www.pricescan.com (Advertiser's Max Bid: \$0.62)

The Overture.com web page specifies the amount bid. This information is omitted on the web pages of the partnering search engine companies, such as yahoo.com and msn.com. The yahoo.com search page for "digital cameras," for example, looks like this:

Sponsor Matches

(What are Sponsor Matches?)

- Digital Cameras from Gateway® - With great deals like these, now is the time to update your digital camera. Check out our huge selection of the latest high performance computers and accessories today.
accessories.gateway.com
- Your Online Source for Digital Cameras - Dell4me has everything you need, from digital cameras to peripherals and more, organized into easy-to-find categories so you can save time and money. We're more than just a computer company.
www.dell4me.com
- Don't Buy It Before You PriceSCAN It! - PriceSCAN is your unbiased guide to finding low prices on digital cameras.
www.pricescan.com
- Deals on Digital Cameras at Tech Depot - Tech Depot by Office Depot lets you choose from over 60,000 low-priced computer and technology products, all with competitive shipping rates. Buy your digital cameras online now.
www.techdepot.com

Applicants respectfully submit that Davis does not anticipate the invention as recited in claim 14.

The Office cites Davis, at Col. 21, lines 7-13 (see February 10, 2003 Final Office Action, page 4, lines 6-11), as showing the feature of, in response to receiving a query corresponding to an inactive identifier, initiating a time-limited auction, a winner of said auction being granted the privilege of associating an internet resource with said identifier for at least a predetermined time period. Applicants respectfully disagree.

The cited Davis passage suggests generating a cost prediction for a search listing at a given price bid. While the cost estimate at a given bid is calculated with respect to a fixed time period, the auction itself is not so limited. A Davis-like advertiser could enter a higher bid at anytime, where a higher bid can always supplant others. Thus, the cited passage is deficient in teaching the initiation of a time-limited auction, where a winner of the auction is granted the privilege of associating an internet resource with the identifier for at least a predetermined time period, in combination with the other features of claim 14.

The final rejection of claim 14 should be reversed.

Claim 16

Claim 16 reads as follows:

16. *A method comprising:*

auctioning to the highest bidder the privilege of defining a link that is to be associated, for a predetermined time period, with an identifier through a database; and at the expiry of said predetermined time period, re-auctioning said privilege.

The Office cites Davis, at Col. 21, lines 23-25 (see the Final Office Action, page 4), as showing the features of auctioning to the highest bidder the privilege of defining a link that is to be associated, for a predetermined time period, with an identifier through a database; and at the expiry of said predetermined time period, re-auctioning said privilege. Applicants respectfully disagree.

The cited passage of Davis deals with generating a cost prediction for a search listing at a given bid, not auctioning a privilege for a predetermined time period and at the expiry of the predetermined time period, re-auctioning the privilege.

The Davis cost projections are estimations for daily run rates and the like, not re-auctions of a privilege of defining a link that is to be associated for a predetermined time period with an identifier through a database.

The final rejection of claim 16 should be reversed.

Claim 17

Claim 17 reads as follows:

17. *The method of claim 16 in which the proceeds of said re-auctioning are shared with the high bidder of a previous auction for said privilege.*

Claim 17 recites that the proceeds of the re-auctioning be shared with the high bidder of a previous auction. Again, column 21 of Davis is cited (at lines 19-25). A careful review of the cited passage reveals no support for such features.

In the example given above with respect to claim 14, if Dell bids \$0.64 for the privilege of being listed first among yahoo.com search results for a “digital camera,” there is nothing in Davis to suggest that part of this fee be shared with Gateway – the high bidder of a previous auction.

And the cited Davis passage deals with generating a cost projection, not sharing proceeds of a re-auction with a high bidder of a previous auction.

The final rejection of claim 17 should be reversed.

Claim 25

Claim 25 reads as follows:

25. The method of claim 14 that includes automatically deriving the identifier using a device maintained by said winner, without requiring said winner to type or otherwise manually enter the identifier.

Please recall that the method of claim 14 recites receiving a query corresponding to an inactive identifier and, in response, initiating a time-limited auction, a winner of the auction being granted the privilege of associating an internet resource with the identifier for at least a predetermined time period.

Claim 15 adds the features of the winner’s device automatically deriving the identifier using a device maintained by the winner, without requiring said winner to type or otherwise manually enter the identifier.

The specification provides examples of such techniques:

Now assume that an up-and-coming band (“The Pinecones”) releases a song in MP3 format. No identifier is affirmatively assigned to the MP3 when it is encoded, but compliant players process the MP3 data to derive an identifier. (An exemplary algorithm may take the first ten frames of MP3 data, and select the 100th data bit from each frame, to yield a ten bit identifier.) The derived identifier may be ‘883.’ A listener of the song

forwards this ‘883’ identifier to the Registry database, hoping thereby to be linked to supplemental information about The Pinecones or the song. (See page 5, line 27 – page 6, line 4).

“Since the ID is automatically generated, it may be different for each bit-rate MP3 release as well as for each CD release.” (See page 6, lines 28-29).

(Of course, these examples are provided for illustrative purposes only, and are not intended to limit the scope of claim 24. It will be appreciated that many other examples and implementations will fall within the scope of claim 24.).

The cited Davis passage, at Col. 16, lines 14-15, deals with automatic notification of a pending *account balance*, not automatic generation of a content identifier by a winner’s device, without requiring the winner to type or otherwise manually enter the identifier.

Applicants respectfully submit that the final rejection of claim 25 is improper and should be reversed.

II. The Office failed to establish a prima facie case of obviousness in rejecting claims 1-5, 7-12, 15, 18-24, 26 and 27 as being unpatentable over Davis in view of Eyal (U.S. Patent No. 6,389,467 B1), since (a) the references – collectively – fail to detail all of the elements claimed, and (b) there is no teaching or suggestion in the art that would have led an artisan to modify and combine the references as proposed.

Claim 1

Claim 1 reads as follows:

1. A method of operating a database that has plural records, the method including receiving queries, each including an identifier, and replying to said queries by reference to information from database records associated with said identifiers, said identifiers being drawn from a universe of possible identifiers, a majority of which do not have active database records

associated therewith, the method including:

receiving a query from a user including an identifier that has no active database record associated therewith, said identifier being derived from an existing media content object; and permitting the user to create an active database record corresponding to said identifier.

One example of deriving an identifier from an existing media content object is provided in the specification at page 2, lines 13-20:

“One way to derive an identifier is to employ selected bits of the content, itself, as the identifier. For example, in MP3 audio, where the signal is encoded into frames, the Nth bit of the first 128 frames of a musical work can be assembled together into a 128 bit identifier. Or data present in MP3 headers can be used. In another approach, some or all of the content data is processed by a hashing algorithm to yield a 128 bit identifier corresponding to that content. *In both of these cases, the identifier is implicit in the audio itself. That is, no data needs to be added* (e.g., in a header, or by steganographic encoding).” (*emphasis added*)

Another example of deriving an identifier from an existing media content object is provided in the specification at page 5, line 28 – page 6, line 2:

“No identifier is affirmatively assigned to the MP3 when it is encoded, but compliant players process the MP3 data to derive an identifier. (An exemplary algorithm may take the first ten frames of MP3 data, and select the 100th data bit from each frame, to yield a ten bit identifier.)”

(These examples should not be interpreted as limiting the scope of claim 1 as there are many other examples and implementations that will fall within the scope of claim 1.)

Again Davis is deficient in supporting an identifier being derived from an existing media

content object in combination with the features of claim 1. A search term – and not a generated “rank value” – is used to identify content in the Davis Scheme. The rank value merely determines a listing order once content is identified.

Applicants also note that Office’s comments on page 2, lines 6-11 of paragraph 3, of the Final Office Action. Applicants disagree that the cited Eyal reference discusses “deriving an identifier from an existing media content object.” While the cited Eyal passage (Col. 12, lines 13-17) may discuss providing access to media via links found at a media site, it does not support an identifier being derived from an existing media content object.

Applicants respectfully submit that an artisan confronted with the Davis and Eyal references would find no incentive to modify and jigsaw together the disparate teachings of the references, absent impermissible use of hindsight.

The Office’s rationale for combining the Davis and Eyal also seems incongruent (see Final Office Action at page 6, lines 5-8). It is unclear how a “media content object” (e.g., audio, video, image, etc.) would provide “necessary infrastructure” to allow a media content object to generate a respective queries.

Applicants respectfully request that the final rejection of claim 1 be reversed.

Claim 2

Claim 2 reads as follows:

2. The method of claim 1 that includes allowing the user to pay a fee, said fee entitling the user to specify at least a portion of the database record corresponding to said identifier.

For the purposes of this appeal, claim 2 is patentable for the same reasons as claim 1 and stands or falls with claim 1.

Claim 3

Claim 3 reads as follows:

3. The method of claim 1 that includes allowing the user to make a first bid in an auction, said auction continuing for a predetermined period commencing with said first bid.

As discussed above, Davis deals with a continual bidding process. At anytime, a bidder may supplant the then highest bidder. The auctioning appears continuous.

Applicants note the Office's comments regarding "predetermined period" on page 2 of the Final Office Action (see paragraph 3, lines 12-18). The Office's statement has been addressed above, but for clarity is reiterated here again. The cited Davis passage (Col. 21, lines 7-21) deals with generating a cost prediction for a search listing at a given bid. While the cost estimate at a given bid is calculated with respect to a fixed time period, the auction itself is not so limited. A Davis-like advertiser could enter a higher bid at anytime; thus, supplanting a higher bid at anytime.

(Moreover, applicants submit that the Office has not established a *prima facie* case of obviousness, as the Office has failed to address each of the limitations of the claim. See Final Office Action at page 7, line 2.).

The final rejection of claim 3 should be reversed.

Claim 4

Claim 4 reads as follows:

4. *A method comprising:*

deriving an identifier corresponding to an existing media content object;

querying a database with the derived identifier; and

if the database has no active record corresponding to said derived identifier, permitting a party who first queried the database with said identifier to define such a record.

Applicants remain puzzled by the Office's rejection of claim 4 over Davis and Eyal. For example, the Office cites Davis at the Abstract, lines 22-34, as teaching "deriving an identifier corresponding to an existing media content object". As best as can be understood by applicants, the Office intended the "rank value" associated with a searching listing to support applicants' deriving step. This conclusion is reached since the "rank value" is the only value derived or

generated in the Davis passage cited by the Office. But Davis' rank value is not used to query a database (*cf. claim 4: "querying a database with the derived identifier"*). Instead, a search term is used to query the search engine (see Davis at its Abstract, lines 27-31).

Moreover, the proposed Davis-Eyal combination is not understood to teach or suggest "*if the database has no active record corresponding to said derived identifier, permitting a party who first queried the database with said identifier to define such a record.*" The cited Davis passage (Col. 5, lines 34-48) contemplates a bidding process, including multiple bids. In contrast, claim 4 would permit a party who first queried the database with the identifier to define a record.

Eyal is not relied upon by the Office to remedy these deficiencies. Nor is it understood to do so.

Respectfully, the final rejection of claim 4 should be reversed.

Claim 5

Claim 5 reads as follows:

5. *The method of claim 4 in which the media content object is an audio file.*

For the purposes of this appeal, claim 5 is patentable for the same reasons as claim 4 and stands or falls with claim 4.

Claim 7

Claim 7 reads as follows:

7. *The method of claim 4 in which the media content object is a video file.*

For the purposes of this appeal, claim 7 is patentable for the same reasons as claim 4 and stands or falls with claim 4.

Claim 8

Claim 8 reads as follows:

8. *The method of claim 4 in which the deriving includes consulting a resource external of the media content object.*

The Office cites Davis, at Col. 8, lines 15-18, as teaching the features of claim 8. Yet the cited Davis passage is directed to content that can be found on web pages. Applicants have carefully studied the cited passage and are unable to find any mention of deriving an identifier corresponding to an existing media content object through consultation with a resource external of the media content object. Indeed, no identifiers are being retrieved from the Davis webpages.

Thus, the final rejection of claim 8 should be reversed.

Claim 9

Claim 9 reads as follows:

9. *The method of claim 8 in which the resource is a database.*

For the purposes of this appeal, claim 9 is patentable for the same reasons as claim 8 and stands or falls with claim 8.

Claim 10

Claim 10 reads as follows:

10. *The method of claim 4 in which the deriving includes processing data from the media content object to obtain said identifier.*

The cited Davis passage, at Col. 5, lines 35-43, does not teach or suggest the combination recited in claim 10. In particular, the cited passage does not teach or suggest processing data from the media content object to derive the identifier. Instead, the cited passage discusses placement of a search result within a search result listing. The search result listing is arranged in

order of decreasing bid amount, with the search listing corresponding to the highest bids displayed first to the searcher.

(Applicants note that Office's comments on page 2, lines 6-11 of paragraph 3, of the Final Office Action. Applicants disagree that the cited Eyal reference discusses "deriving an identifier from an existing media content object." The cited Eyal passage (Col. 12, lines 13-17) discusses providing access to media via links found at a media site, but not "deriving" identifiers.)

The final rejection of claim 10 should be reversed.

Claim 11

Claim 11 reads as follows:

11. The method of claim 4 in which several identifiers can correspond to the same media content object.

The Office cites the now familiar Davis passage, at Col. 5, lines 35-43, as teaching that several identifiers can correspond to the same media content object. Again applicants must respectfully disagree.

The cited passage discusses that several search result listing are shown in response to a search term query. But this seems, at best, juxtaposed to applicants' claimed features. Claim 11 recites that several identifiers correspond to the same media content object, not one identifier corresponding to several media content objects. (Moreover, the Office's seems to have taken a position that a "rank value" corresponds to an identifier, as discussed with respect to claim 4 above. In this regard, the cited passage at Davis Col. 5 does not even support that several rank values are associated with the same media content object. Davis associates a single ranking with each listing.).

Thus, the final rejection of claim 11 should be reversed.

Claim 12

Claim 12 reads as follows:

12. *The method of claim 11 in which the identifiers are automatically generated from different releases of an audio CD, wherein the releases have different audio and/or table of contents.*

The Office failed to establish that the cited art teaches or suggests that the identifiers are automatically generated from different releases of an audio CD, wherein the releases have different audio and/or table of contents.

There is no analysis or discussion of the claimed features by the Office. Thus, the Office has not established a *prima facie* case of obviousness for claim 12.

Moreover, the cited passage at Davis, Col. 8, lines 15-18 does not even mention automatic generation, let alone generation from different releases of an audio CD, wherein the releases have different audio an/or table of contents.

The final rejection of claim 12 should be reversed.

Claim 15

Claim 15 reads as follows:

15. (original): *The method of claim 14 in which said active identifiers correspond to different audio content, and the internet resources corresponding to said active identifiers correspond to said audio content.*

Applicants remain baffled by the Office's rejection of claim 15 (see February 10, 2003 Final Office Action (hereafter "Final Office Action"), page 8, lines 4-8 of paragraph 8). The Office suggests that claim 15 is rejected over the combination of Davis and Eyal, yet the Office fails to apply Eyal against claim 15. (Base claim 14 stands rejected over Davis alone.).

The cited Davis passage fails to support active identifiers corresponding to different audio content, and the internet resources corresponding to the active identifiers correspond to the audio

content. Instead, Davis at the cited passage deals with displaying search results from a search engine.

Moreover, applicants respectfully submit that an artisan confronted with the Davis and Eyal references would find no incentive to modify and jigsaw together the disparate teachings of the references, absent impermissible use of hindsight. For sake of brevity, this position is not hereafter repeated.

(The Office has also failed to establish a *prima facie* case of obviousness since it did not even address the rationale for combining Davis and Eyal with respect to claim 15. See, e.g., the Final Office Action at page 8, lines 1-8 of paragraph 8. Moreover, Eyal is not relied on for any deficiencies of Eyal, nor is it understood to remedy such deficiencies. For sake of brevity, this position is not hereafter repeated with respect to many of the below discussed claims.).

The final rejection of claim 15 should be reversed.

Claim 18

Claim 18 reads as follows:

18. *The method of claim 16 in which the identifier corresponds to an existing media content object.*

For the purposes of this appeal, claim 18 is patentable for the same reasons as claim 16 and stands or falls with claim 16.

Claim 19

Claim 19 reads as follows:

19. *The method of claim 18 in which the identifier is derived, rather than assigned.*

The Davis Abstract is cited (at lines 27-29) as supporting the feature of deriving the identifier, rather than assigning one. Applicants suppose that the Office intended the “rank value,” which is generated by the bidding process, to support the claim 19 features. As discussed

above, this is an incongruent argument, since Davis uses a “search term” to find search results, and not a rank value. The rank value comes into play only when determining an order to display the search result listings.

(Applicants again note the Office’s comments on page 2, lines 6-11 of paragraph 3, of the Final Office Action. Applicants disagree that the cited Eyal reference discusses “deriving an identifier from an existing media content object.” The cited Eyal passage (Col. 12, lines 13-17) discusses providing access to media via links found at a media site, but not “deriving” the media links.)

Applicants respectfully request that the final rejection of claim 19 be reversed.

Claim 20

Claim 20 reads as follows:

20. *The method of claim 1 wherein a primary function of the database is to link consumers to internet resources, such as web pages, that promote goods or services that are related to the media content objects and that are offered by commercial entities, and said user is one of said consumers, wherein the consumer can participate in such linking in a manner customarily reserved to the commercial entities.*

Davis deals with prioritizing a website listing within a search result generated by a search engine. A website listing (e.g., a Gateway website URL) is typically promoted by Gateway to promote goods (e.g., computers) that are offered by Gateway.

In contrast, claim 20 envisions that a consumer (e.g., one that is not offering the goods) is able to participate in linking in a manner customarily reserved to the commercial entity (e.g., Gateway).

The cited passage of Davis at Col. 7, lines 45-55 is deficient in this regard. Indeed, the cited Davis passage merely discusses different network configurations.

The final rejection of claim 20 should be reversed.

Claim 21

Claim 21 reads as follows:

21. The method of claim 1 that includes automatically providing the identifier from a process on a user device - such as a computer - to the database, without requiring the user to type or otherwise manually enter the identifier.

Recall, here, that the method of claim 1 recites receiving a query from a user including an identifier that has no active database record associated therewith, the identifier being derived from an existing media content object.

Claim 21 adds the features of automatically providing the identifier from a process on a user device - such as a computer - to the database, without requiring the user to type or otherwise manually enter the identifier.

The cited Davis passage at Col. 14, lines 38-39 invokes a function in response to a mouse click that receives data identifying an advertiser and retrieves the advertiser's account from a database, but fails to support applicant's recited claim features.

Moreover, there is no suggestion at Col. 14, lines 38-39, that the account identifier is derived from an existing media content object.

The final rejection of claim 21 should be reversed.

Claim 22

Claim 22 reads as follows:

22. The method of claim 4 wherein a primary function of the database is to link consumers to internet resources, such as web pages, that promote goods or services that are related to media content objects and that are offered by commercial entities, and said party is one of said consumers, wherein the consumer can participate in such linking in a manner customarily reserved to the commercial entities.

Davis deals with positioning a website listing within a search result generated by a search engine. The website listing (e.g., a Gateway website URL) is typically promoted by Gateway to

promote goods (e.g., computers) that are offered by Gateway.

In contrast, claim 22 envisions that a consumer (e.g., one that is not offering the goods) is able to participate in linking in a manner customarily reserved to the commercial entity (e.g., Gateway).

The cited passage of Davis at Col. 7, lines 45-55 is not helpful in this regard. Instead, the cited Davis passage merely discusses different network configurations.

Accordingly, the final rejection of claim 22 should be reversed.

Claim 23

Claim 23 reads as follows:

23. The method of claim 1 that includes automatically providing the identifier from a process on a device maintained by said party - such as a computer - to the database, without requiring said party to type or otherwise manually enter the identifier.

Claim 23 recites an identifier that is derived from an existing media content object.

But the Office cites Davis at Col. 16, lines 14-15. The cited passage is out of context as it deals with an automatic notification of an account balance. Nowhere in the cited passage does Davis tie the notification to an identifier derived from an existing content item. Instead, Davis would simply notify an advertiser regarding their account balance.

The final rejection of claim 23 should be reversed.

Claim 24

Claim 24 reads as follows:

24. The method of claim 14 wherein said identifiers and internet resources are associated through a database, a primary function of which is to link consumers to internet resources that promote goods or services that are related to media content objects and that are offered by commercial entities, and said winner is one of said consumers, wherein the consumer

can participate in such linking in a manner customarily reserved to the commercial entities.

With all due respect to the Office's position, the rejection of claim 24 is helpful to illustrate the impropriety of applying Davis against the recited claim language.

Davis deals with positioning a website listing within a search result generated by a search engine. The website listing (e.g., a Gateway website URL) is typically promoted by Gateway to promote goods (e.g., computers) that are offered by Gateway.

In contrast, claim 24 envisions that a consumer (e.g., one that is not offering the goods) is able to participate in linking in a manner customarily reserved to the commercial entity (e.g., Gateway).

The cited passage of Davis, at Col. 7, lines 45-55, is not helpful in this regard. Instead, the cited Davis passage discusses different network configurations.

Accordingly, the final rejection of claim 24 should be reversed.

Claim 26

Claim 26 reads as follows:

26. The method of claim 16 wherein a primary function of the database is to link consumers to internet resources that promote goods or services that are related to media content objects.

For the purposes of this appeal, claim 26 is patentable for the same reasons as claim 16 and stands or falls with claim 16.

Claim 27

Claim 27 reads as follows:

27. The method of claim 16 that includes automatically deriving the identifier from a media content object.

One example of deriving an identifier from a media content object is provided in the specification at page 2, lines 13-20:

“One way to derive an identifier is to employ selected bits of the content, itself, as the identifier. For example, in MP3 audio, where the signal is encoded into frames, the Nth bit of the first 128 frames of a musical work can be assembled together into a 128 bit identifier. Or data present in MP3 headers can be used. In another approach, some or all of the content data is processed by a hashing algorithm to yield a 128 bit identifier corresponding to that content. *In both of these cases, the identifier is implicit in the audio itself. That is, no data needs to be added* (e.g., in a header, or by steganographic encoding).” (*emphasis added*)

Another example of automatically deriving an identifier from a media content object is provided on page 6, lines 28-29 of the specification:

“Since the ID is automatically generated, it may be different for each bit-rate MP3 release as well as for each CD release.”

(Of course, these examples are not meant to limit the scope of claim 27, as many other examples and implementations will fall within the scope of claim 27.)

Claim 27 requires that the identifier be derived from the media content. In contrast, the cited Davis passage at Col. 14, lines 38-39, invokes a function (in response to a mouse click) that receives data identifying an advertiser and retrieves the advertiser’s account from a database (*emphasis added*). No support for deriving the identifying data from media content is found in the relied upon passage.

(Applicants again note the Office’s comments on page 2, lines 6-11 of paragraph 3, of the Final Office Action. Applicants disagree that the cited Eyal reference discusses “deriving an

identifier from an existing media content object.” The cited Eyal passage (Col. 12, lines 13-17) discusses providing access to media via links found at a media site, but not “deriving” the media links.)

Applicants respectfully request that the final rejection of claim 27 be reversed.

III. The Office failed to establish a prima facie case of obviousness in rejecting claims 6 and 13 as being unpatentable over Davis in view of Eyal and in further view of Thomas (U.S. patent No. 6,401,118 B1), since (a) the references – collectively – fail to detail all of the elements claimed, and (b) there is no teaching or suggestion in the art that would have led an artisan to modify and combine the references as proposed.

Claim 6

Claim 6 reads as follows:

6. The method of claim 4 in which the media content object is an MP3 audio file.

For the purposes of this appeal, claim 6 is patentable for the same reasons as claim 4 and stands or falls with claim 4.

Claim 13

Claim 13 reads as follows:

13. The method of claim 11 in which the identifiers are automatically generated from different versions of an MP3 file, wherein the versions have different bits due to the compression and/or bit-rate.

The Office has failed to establish a *prima facie* case of obviousness with respect to claim 13.

The fact that Thomas mentions the term “MP3” is not sufficient to render claim 13 unpatentable. Indeed, the Office has failed to discuss how the proposed combination of Davis,

Eyal and Thomas teaches such claim features such as automatically generating identifiers from different versions of an MP3, wherein the version have different bits due to the compression and/or bit-rate.

These claim features were not even discussed in the Final Office Action (see page 9, lines 15-24 of paragraph 9), nor are they understood to be supported by the proposed art combination.

Moreover, applicants respectfully submit that an artisan confronted with the Davis, Eyal and Thomas references would find no incentive to modify and jigsaw together the disparate teachings of the references.

Accordingly, the final rejection with respect to claim 13 should be reversed.

CONCLUSION AND REQUEST FOR REVERSAL

The cited references collectively fail to disclose all of the limitations of the pending claims. (Other deficiencies of the art need not be further belabored at this time.) As such, the claims are patentable over the cited references.

Applicants respectfully request that the Board reverse the final rejection of the pending claims.

Date: December 2, 2003

Respectfully submitted,

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APPENDIX
(PENDING CLAIMS)

1. (original): A method of operating a database that has plural records, the method including receiving queries, each including an identifier, and replying to said queries by reference to information from database records associated with said identifiers, said identifiers being drawn from a universe of possible identifiers, a majority of which do not have active database records associated therewith, the method including:

receiving a query from a user including an identifier that has no active database record associated therewith, said identifier being derived from an existing media content object; and permitting the user to create an active database record corresponding to said identifier.

2. (original): The method of claim 1 that includes allowing the user to pay a fee, said fee entitling the user to specify at least a portion of the database record corresponding to said identifier.

3. (original): The method of claim 1 that includes allowing the user to make a first bid in an auction, said auction continuing for a predetermined period commencing with said first bid.

4. (original): A method comprising:

deriving an identifier corresponding to an existing media content object;

querying a database with the derived identifier; and

if the database has no active record corresponding to said derived identifier, permitting a party who first queried the database with said identifier to define such a record.

5. (original): The method of claim 4 in which the media content object is an audio file.

6. (original): The method of claim 4 in which the media content object is an MP3 audio file.

7. (original): The method of claim 4 in which the media content object is a video file.

8. (original): The method of claim 4 in which the deriving includes consulting a resource external of the media content object.

9. (original): The method of claim 8 in which the resource is a database.

10. (original): The method of claim 4 in which the deriving includes processing data from the media content object to obtain said identifier.

11. (original): The method of claim 4 in which several identifiers can correspond to the same media content object.

12. (original): The method of claim 11 in which the identifiers are automatically generated from different releases of an audio CD, wherein the releases have different audio and/or table of contents.

13. (original): The method of claim 11 in which the identifiers are automatically generated from different versions of an MP3 file, wherein the versions have different bits due to the compression and/or bit-rate.

14. (previously presented): A method of managing a universe of identifiers, some of said identifiers being active and having internet resources associated therewith, and others of said identifiers being inactive, the method including receiving a query corresponding to an inactive identifier and, in response, initiating a time-limited auction, a winner of said auction being granted the privilege of associating an internet resource with said identifier for at least a predetermined time period.

15. (original): The method of claim 14 in which said active identifiers correspond to different audio content, and the internet resources corresponding to said active identifiers correspond to said audio content.

16. (original): A method comprising:

auctioning to the highest bidder the privilege of defining a link that is to be associated, for a predetermined time period, with an identifier through a database; and
at the expiry of said predetermined time period, re-auctioning said privilege.

17. (original): The method of claim 16 in which the proceeds of said re-auctioning are shared with the high bidder of a previous auction for said privilege.

18. (original): The method of claim 16 in which the identifier corresponds to an existing media content object.

19. (original): The method of claim 18 in which the identifier is derived, rather than assigned.

20. (previously presented): The method of claim 1 wherein a primary function of the database is to link consumers to internet resources, such as web pages, that promote goods or services that are related to the media content objects and that are offered by commercial entities, and said user is one of said consumers, wherein the consumer can participate in such linking in a manner customarily reserved to the commercial entities.

21. (previously presented): The method of claim 1 that includes automatically providing the identifier from a process on a user device - such as a computer - to the database, without requiring the user to type or otherwise manually enter the identifier.

22. (previously presented): The method of claim 4 wherein a primary function of the database is to link consumers to internet resources, such as web pages, that promote goods or services that are related to media content objects and that are offered by commercial entities, and said party is one of said consumers, wherein the consumer can participate in such linking in a manner customarily reserved to the commercial entities.

23. (previously presented): The method of claim 1 that includes automatically providing the identifier from a process on a device maintained by said party - such as a computer - to the database, without requiring said party to type or otherwise manually enter the identifier.

24. (previously presented): The method of claim 14 wherein said identifiers and internet resources are associated through a database, a primary function of which is to link consumers to internet resources that promote goods or services that are related to media content objects and that are offered by commercial entities, and said winner is one of said consumers, wherein the consumer can participate in such linking in a manner customarily reserved to the commercial entities.

25. (previously presented): The method of claim 14 that includes automatically deriving the identifier using a device maintained by said winner, without requiring said winner to type or otherwise manually enter the identifier.

26. (previously presented): The method of claim 16 wherein a primary function of the database is to link consumers to internet resources that promote goods or services that are related to media content objects.

27. (previously presented): The method of claim 16 that includes automatically deriving the identifier from a media content object.